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Fred H. Zollinger, III
SAND & SEBOLT
Aston Park Professional Centre
4801 Dressler Rd., NW, Suite 194
Canton, OH 44718-3669

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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3637

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,074

Applicant(s)

REICHERT, GERHARD

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-30,32-34 and 36-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-30,32-34,36-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 23, 26, 28-30, 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoakes (4756131).

Stoakes (figure 2) shows a muntin grid piece comprising a rigid inner muntin grid element (42), a flexible collapsible outer muntin grid element (44), when separated from the inner muntin grid element, the collapsible outer muntin grid element being capable of being collapsed upon itself to a collapsed position (inherently so) and reopened to an open position wherein the outer muntin grid element defines a longitudinal opening, the outer muntin grid element substantially surrounding the inner muntin grid element to hide the inner muntin grid element (42) from view on both sides of the window when the muntin grid piece is installed, the

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outer element defining a slit (the opening in the middle of part 44), the outer element being in the form of a tube disposed around the inner muntin grid element, the outer element is connected to the inner muntin grid element with a connector (the slot or groove where edge of part 42 is extended), the outer element including at least one protruding foot (the parts which press against the glass panes) that increases the width of the outer muntin element, the outer element being resilient.

3. Claims 23-29, 32-34, 36-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Peterson (6351923).

Peterson (figure 2, 7) shows simulated divided lite insulating glazing unit having an internal muntin bar, the unit comprising first and second spaced glass sheets (14a, 14b) defining an insulating chamber, a muntin bar disposed within the insulating chamber, the bar having an inner muntin grid element (126, figure 8), a flexible, collapsible outer muntin grid element (64, figure 2), when separated from the inner muntin grid element, the collapsible outer muntin grid element being capable of being collapsed upon itself to a collapsed position and reopened to an open position wherein the outer muntin grid element defines a longitudinal opening (inherently so), outer element being a collapsible and resilient flexible tube having an inner surface and an outer surface, the collapsible tube being capable of being collapsed upon itself and reopened to a tube form, the outer element substantially surrounds the inner muntin grid element, the tube defining a longitudinal slit (the opening of the U-shape tube) to be wrapped around the inner muntin grid element, the slit extending from the inner surface to the outer surface of the outer muntin grid element, the outer element being fabricated from a foam material with desiccant, the slit extending from the inner surface to the outer surface through the sidewall of the tube

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(essentially so as the slit forming the opening through the side wall at the top of the structure) element defining a slit (the opening in the middle of part 126 forming the U-shape), the slit in the outer element defining opposed ends with the opposed ends being angled away from each other (inherently so, figures 1-2), the inner muntin grid element having a longitudinal direction, a plurality of spaced corners and a cross sectional perimeter dimension measured about a cross section viewed normal to the longitudinal direction of the inner muntin grid element, the outer element having a body having spaced parallel longitudinal ends that define the width of the body, the width being substantially equal to the cross section perimeter dimension of the inner muntin grid element, the body defining one corner notch for each corner of the inner muntin grid element (figure 8), the corner notches being spaced apart to align with the corners of the inner muntin grid element when the body is wrapped around the inner muntin grid element, an adhesive connected to the body, the adhesive adapted to connect the body to the inner muntin grid element when the body is wrapped around the inner muntin grid element.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stoakes (4756131) in view of Donaldson (6192651).

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Stoakes shows all the claimed limitations except for the outer element being fabricated from a foam material.

Donaldson discloses foam material (24) forming an outer element.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Stoakes to show the outer element being fabricated from a foam material as taught by Donaldson because foam material is a well known material for forming a grid element as it has great heat insulation property and light weight.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stoakes (4756131) in view of Donaldson (6192651) as applied to claim 24 above and further in view of Baier (5345743).

Stoakes as modified shows all the claimed limitations except for the outer element having a desiccant.

Baier discloses desiccant within an insulated glass to absorb moisture within the glass chamber.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Stoakes's modified structure to show the outer element being the outer element having a desiccant as taught by Baier because it would help absorb moisture seeping into the double layer glass panel and thus keeping the panel clear.

Response to Arguments

1. Applicant's arguments filed 8/26/04 have been fully considered but they are not persuasive.

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2. With respect to applicant's arguments to Stoakes per claims 23, 26, 28-30, examiner respectfully points out that Stoakes shows all the structural limitations as claimed.
3. In response to applicant's argument that Stoakes' teaching is not to muntin grid piece, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The argument is thus moot.
4. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The argument is thus moot.
5. With respect to applicant's statements that there are no motivation to modify Stoakes's structures to show the claimed limitations, examiner respectfully points out that the claims 23, 26, 28-30 are rejected under 102 (b), without any modification required. The 103 rejections are to claims 24, 25 only. The argument is thus moot.
6. With respect to the Martin reference, examiner respectfully points out that the reference Martin was not in the last office action of 4/22/04. The argument is thus moot.
7. With respect to the "collapsibility" of Stoakes, Stoakes inherently can fold as claimed. The argument is thus moot.
8. Applicant's arguments to Baratuci are moot as the rejection based upon is withdrawn.

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9. With respect to the reference Peterson, examiner respectfully points out that the reference shows all the claimed limitations. In response to applicant's argument that Peterson's teaching is not to the muntin bar, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The argument is thus moot.

10. With respect to Peterson's parts (64, 126) of inner and outer grid element, examiner respectfully points out that the reference teaches all the claimed limitations as pointed out above. The argument is thus moot.

11. With respect to the combination of Stoakes, Donaldson and Baier, examiner respectfully states that the combination shows all the claimed limitations.

12. With respect to Martin and combinations thereof, examiner respectfully submits that no rejection was based on Martin in the last office action of 4/22/04. The argument is thus moot.

13. With respect to claims 27 and 42, examiner respectfully points out that the ends of the slits shown in figures 1-2 of Peterson are angled away from each other. The argument is thus moot.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phi Dieu Tran A *PA*

11/19/04

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Lanna Mai